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No. 96-1093

In The

Supreme Court of the United States

October Term, 1996

CRYO-TRANS, INC.,

Petitioner,

vs.

GENERAL AMERICAN TRANSPORTATION CORPORATION,

Respondent.

On Petition For Writ Of Certiorari To The United States Court Of Appeals For The Federal Circuit

BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

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STATEMENT UNDER RULE 14.1(b) AND 29.6

The names of all parties to this proceeding in the court whose judgment is sought to be reviewed appear in the caption of this brief in opposition.

The parent company of respondent General American Transportation Corporation is GATX Corporation.

Respondent General American Transportation Corporation does not have any nonwholly-owned subsidiaries.

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BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

Respondent General American Transportation Corporation ("GATC") submits this brief in opposition to Cryo-Trans' Petition for a Writ of Certiorari. Respondent respectfully submits that this Court should deny the Petition to review the judgment of the Court of Appeals for the Federal Circuit in this case.

SUMMARY OF ARGUMENT

The question of the appropriate standard for reviewing a district court's interpretation of a claim of a patent (that is presented by the Petition) necessarily was decided by this Court in *Markman v. Westview Instruments*, 517 U.S.___, 116 S.Ct. 1384, 1387 (1996), wherein this Court unambiguously held that "the construction of a patent, including terms of art within its claims, is exclusively within the province of the court." Petitioner now requests this Court to find that claim construction is an issue of fact subject to Rule 52 of the Federal Rules of Civil Procedure, when this Court clearly has held that it is not. This Court plainly recognized in *Markman* the benefits to the judicial process of treating "interpretive issues," such as construction of patent claims, "as purely legal." *Markman*, 517 U.S. at ___, 116 S.Ct. at 1396. Having decided that claim construction will be treated as an issue of law for a court – not an issue of fact for a jury – and having affirmed the Court of Appeals for the Federal Circuit, this Court signaled the application of general appellate rules with respect to the standard of review

applicable to questions of law. Under well established appellate jurisprudence, questions of law, including questions of patent claim construction, are subject to a *de novo* standard of review.

Thus, the fundamental premise of the Petition by Cryo-Trans is flawed: the issue presented is not an important unresolved issue. Indeed, the *in banc* decision by the Federal Circuit in *Markman*, which this Court affirmed, expressly held that "[b]ecause claim construction is a matter of law, the construction given the claims is reviewed *de novo* on appeal." *Markman v. Westview Instruments*, 52 F.3d 967, 979 (Fed.Cir. 1995) (in banc), *aff'd*, 517 U.S.___, 116 S.Ct. 1384 (1996). The Petition does not suggest any conflict between any decisional law. The Petition does not provide any compelling reasons for the exercise of this Court's discretion. The Petition does not present any reason why this Court now should revisit its recent, unanimous decision in *Markman*.

COUNTER STATEMENT OF THE CASE

The issues before the Court of Appeals for the Federal Circuit in this case presented only a straightforward application of well established principles of law; the appeal to the Federal Circuit did not raise any precedent-setting issues or any conflicts in decisional law which required resolution. The appeal did not question the standard of review applicable to the issue of claim construction, or even suggest that the Federal Circuit's methodology for resolving issues of claim construction required either a major overhaul or even a modest tune

up. Indeed, Petitioner's appeals Brief readily conceded that claim construction is a matter of law. Consistent with *Markman v. Westview Instruments*, 52 F.3d 967, 979 (Fed. Cir. 1995) *(in banc), aff'd*, 517, U.S. ___, 116 S.Ct. 1384 (1996), the Federal Circuit here treated the issue of the proper interpretation of disputed language in a patent claim as a question of law, subject to a *de novo* standard of review. This is the very same approach that has been followed consistently by the Federal Circuit since its landmark decision in *Markman* was affirmed by this Court

During the course of this case, the parties essentially were in agreement that GATC did not infringe the patent-in-suit if the claims were interpreted in the manner urged by GATC, which was the construction given to the claims by the Magistrate Judge (after a multi-day preliminary injunction hearing) and initially adopted by the district court. The parties also agreed that GATC did indeed infringe the patent if the claims were construed in the way advocated by Cryo-Trans and accepted by the district court after trial. The validity/invalidity assertions depended on which construction of the claims was adopted. GATC essentially acknowledged validity if the patent was construed as GATC urged, but challenged validity if the patent claims were construed in the way advanced by Petitioner. Having agreed with GATC that the district court's claim construction was not correct as a matter of law, because the disputed claim language should be given the ordinary meaning manifest from the patent and file history, the Federal Circuit deemed

GATC's validity challenge no longer pertinent, and therefore declined to otherwise speculate on invalidity of the properly construed claims. (App. 12a.)

The patent-in-suit (the '876 Patent) concerns a cryogenic railcar for transporting frozen food. Cryogenic railcars use carbon dioxide (CO_2) as the refrigerant, whereas conventional refrigerated cars employ more expensive mechanical refrigeration systems. (App. 2a.)

The invention of the patent was an improvement in a crowded art. The cryogenic railcar claimed in the '876 patent was one of many cryogenic systems for containers that received a patent. (App. 30a, 31a, 36a, 39a, 40a, 43a.) In the claimed invention of the '876 patent, the railcar has an insulated compartment that extends lengthwise at the upper portion of the interior of the car forming a bunker which overlies the load. The bunker is charged with CO_2 gas. The bunker floor has a plurality of openings "adjacent each" of the corrugated side walls and corrugated end walls to permit sublimated carbon dioxide gas to flow down each of the walls and surround or envelope the load.

Every element of each patent claim except the element requiring separate openings along each of the four walls, was in the prior art, as the district court found (and those findings were unassailed on appeal).

- "The [prior art] Kurth patent discloses a cryogenic refrigerated railcar with an overhead solid carbon dioxide bunker system having a plurality of openings arranged along the side walls for downward flow into the cargo area of sublimated CO_2 gas." (App. 40a.)

- "The use of carbon dioxide as a refrigerant and the use of a bunker to hold carbon dioxide snow is all part of and taught by the prior art." (App. 45a.)
- "The use of openings in the ceiling of or in a bunker beneath the roof of a container to allow carbon dioxide gas to escape to and envelop the cargo is all part of and taught by the prior art."*(Id.)*
- "The use of channeled or corrugated walls to permit the flow of the carbon dioxide gas towards the floor beneath the cargo, and the use of sinuous channels for this purpose is all part of and taught by the prior art." *(Id.)*
- "The use of all-air flooring, including the use of open top lengthwise channels to review the carbon dioxide gas, was all part of and taught by the prior art." *(Id.)*

Even the Burlington Northern cryogenic railcar design (which Petitioner now calls a failure) was virtually identical to the car claimed in the patent, with one major exception: the openings in the bunker in the Burlington Northern cars were along only one side wall. (App. 9a, 29a, 44a.) This design caused hot spots along the wall furthest away from the openings. (App. 9a, 31a.)

GATC entered the business by designing a railcar to avoid infringement of the properly construed claims of the patent. (App. 50a.) GATC's Arcticar eliminated the openings adjacent or along the end walls of the car, thus leaving a structure with openings adjacent only to the side walls. (App. 22a, 50a.) Moreover, GATC's car, unlike the car claimed in the patent, uses a dispersement chamber effect, as found by the district court (App. 49a-50a),

and thus the Arcticar functioned differently than the car claimed in the '876 patent. Indeed, in November of 1991, GATC obtained U.S. Patent No. 5,168,717 which covered the design of its Arcticar. (App. 22a.)

Although the Arcticar did not have openings adjacent to the end walls, as the district court noted (App. 22a), the district court nonetheless found infringement because under its claim construction any opening that is not far off a wall is "adjacent" to that wall. Of course, in a relatively small structure like a 9' x 68' railcar, everything is "not far off" all walls. Thus, according to the district court's analysis, an opening 3 inches from a side wall and 2 feet 9 inches from an end wall could perform double duty as being adjacent to both walls, despite claim language, drawings, and disclosures in the specification which required a plurality of separate openings dedicated to each wall which were adjacent to one wall by their close proximity to that one wall. Indeed, under the district court's construction, one opening could be adjacent to at least three, and maybe even four walls, depending on its placement.

Although the district court cited *Markman*, it did not examine the full language of the claims, the disclosures in the specification, or the arguments in the file history in reaching its construction of the claims. Rather, it focused only on the word "adjacent." The district court relied on a dictionary definition of the word "adjacent" and noted that a patent lawyer (Mr. Gerstman) had expressed the view at trial that "adjacent" as used in patents generally means "not necessarily at, but nearby or near." (See App. 43a, 52a.)

At trial, GATC did not seek to introduce patent lawyer expert testimony to refute Mr. Gerstman's testimony regarding the general meaning of "adjacent" in patents. Rather, at trial, and then on appeal, GATC argued that it was error to decide the meaning of disputed language by resorting to extrinsic evidence, such as patent lawyer testimony or a dictionary definition of a single isolated word in a disputed limitation of a claim. The language of the claim as a whole, as supported by the specification and file history, argued GATC, made the scope of the claims absolutely clear. Indeed, a definition of "not far off" is only one of many dictionary definitions of "adjacent" and some of the other definitions actually compelled a different definition which supported GATC's view of the claims. And, Mr. Gerstman's testimony of general meanings in other patents of the word "adjacent" could not change the clear meaning of the disputed limitation here when that meaning is absolutely clear from the patent itself.

Thus, GATC merely urged the Federal Circuit to follow *Markman* and consider the clear language of the patent. There were no credibility determinations made by the trial judge, no factual inferences drawn by the trial judge, and no fact findings relating to claims construction with which the appeals court had to contend. The district court merely relied on extrinsic evidence to the exclusion of intrinsic evidence in reaching a legal conclusion.

The Federal Circuit's decision in this case reflects nothing more than a traditional application of *Markman* and other well established rules of claim construction. The Federal Circuit carefully reviewed the distict court's findings and conclusions. It observed that the asserted

claims clearly require "that the openings adjacent to the side walls are structurally distinct from the openings adjacent to the end walls." (App. 7a.) The Federal Circuit found that the "district court's claim construction obliterated that distinction." (*Id.*)

The Federal Circuit then reviewed the specification and file history and concluded that the meaning of the disputed limitation, which was manifest from the claims, was clearly supported by the specification (the file history was not particularly helpful). (App. 8a.) The Federal Circuit rejected the district court's claim construction because it was "inconsistent with the specification and drawings and rendered superfluous the claim requirement for openings adjacent to the end walls." (*Id.*) The Federal Circuit's decision thus not only was consistent with *Markman*, but also with the unassailable precedent which holds that claims construction may not erase important limitations in the claim. *E.g., Perkin-Elmer Corp. v. Westinghouse Elec. Corp.*, 822 F.2d 1528, 1532 (Fed. Cir. 1987), *cert. denied*, 485 U.S. 961 (1988).

This was not a case where the Federal Circuit merely ignored the trial judge's claim construction. The Federal Circuit decided that the district court's claim construction was legally erroneous because it destroyed limitations in the claim and was inconsistent with the patent. Indeed, the district court did not once mention the language of the patent in arriving at its construction; whereas the Federal Circuit, as it was required to do, examined the patent in detail, and quoted extensively from it in reaching a conclusion. Since the meaning of the disputed language was absolutely clear from the patent, there was no need to resort to extrinsic evidence, especially since that

limited extrinsic evidence led to an interpretation which was inconsistent with the patent and also created substantial issues of invalidity. The Federal Circuit reversed the district court because GATC did not infringe the properly construed claims.

REASONS TO DENY THE PETITION

I. The Issue Presented By The Petition Was Decided By This Court In *Markman*.

Petitioner essentially asks this Court to revisit the Court's decision in *Markman v. Westview Instruments*, 517 U.S. ___, 116 S.Ct. 1384 (1996), now, less than one year after it was decided. Petitioner asks this Court to raise extrinsic evidence to a new and dispositive level. According to Petitioner, whenever a trial judge credits extrinsic evidence, notwithstanding clear legal error in failing to consider properly the patent or its file history, the Federal Circuit must defer to the trial court's claim construction because it has become a factual determination subject to Rule 52(a) of the Federal Rules of Civil Procedure. Petitioner is wrong. Indeed, the very issue it now urges as an important unresolved issue was necessarily decided by this Court in *Markman*. A district court's construction of the claim of a patent is a question of law and as such it is subject to review *de novo*.

In its *in banc* decision in *Markman*, the Federal Circuit grappled with the issue of whether claim construction belonged to the jury as a matter of fact or was within the province of the court as an issue of law. This was an

important distinction for purposes of appeal "[s]ince matters of law must be reviewed *de novo* and matters of fact must be accorded substantial deference . . . " *Markman*, 52 F.3d at 976. Reviewing precedent, fundamental principles of American law and the interests of the patent system, the Federal Circuit plainly decided that claim construction was a question of law subject to *de novo* review. *Id.* at 976-979. This Court affirmed, and by doing so, answered the question now presented by the Petition: a district court's claim construction is accorded *de novo* review because it is to be treated as a question of law.

This Court's decision in *Markman* squarely addressed the issue "whether the interpretation of a so-called patent claim . . . is a matter of law reserved entirely for the court . . . " *Markman*, 517 U.S. at ___, 116 S.Ct. at 1387. It held that it was. *Id.* Having determined that the interpretation of a claim of a patent is exclusively in the province of a court as a question of law, this Court necessarily concluded, as did the Federal Circuit, that the issue was subject to *de novo* review. Petitioner's claim that the issue of claim construction presents a mixed issue of law and fact, which should be treated as an issue of fact subject to the clearly erroneous standard of Fed. R. Civ. P. 52(a), ignores the holding by the *Markman* Court that all issues of claim construction will be treated as a question of law for a court irrespective of any factual underpinnings in the decisional process. *Markman*, 517 U.S. at ___, 116 S.Ct. at 1395-96. Indeed, when this Court decided in *Markman* that the issue of claim construction is exclusively for a court as one of law (and not for a jury in any respect), this Court necessarily decided that the issue also is one of law for appeals purposes. It would be tantamount to legal sophistry to withhold an issue from a jury

because it is a question of law, and then to transform the same issue into a question of fact on appeal when it is decided by a trial judge. Yet, that is the position urged in the Petition.[1]

The distinctions for purposes of review between a matter of fact and a question of law is ingrained into our system of appellate jurisprudence. It is well settled that appellate courts accept findings of fact that are not clearly erroneous, but decide questions of law *de novo*. *First Options v. Kaplan*, 514 U.S. ___, ___, 115 S.Ct. 1920, 1926 (1995); *Elder v. Holloway*, 510 U.S. 510, 516 (1994); *Pierce v. Underwood*, 487 U.S. 552, 558 (1988).

The Petitioner, however, says that such a rule is "unfair to litigants who invest heavily in the district court's trial process of receiving evidence and assessing claim construction, only to have the decision ignored by the appellate court." (Petition at pp. 16-17). This assertion rests on a fundamental misunderstanding of the appellate process and the role of a patent in defining the meaning of claims.

The claims of a patent define the metes and bounds of an invention. The patent and its prosecution history are public documents upon which persons are entitled to rely as aids in determining the meaning of a patent claim. These public documents, and especially the patent claims when clear on their face, establish what a competitor may or may not do in introducing a product to the market.

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[1] While essentially asking this Court to revisit the *Markman* Court's holding, it is noteworthy that the Petitioner never defines precisely what fact findings of the trial court the Federal Circuit should have given deference in this case.

"[I]t is only fair (and statutorily required) that competitors be able to ascertain to a reasonable degree the scope of the patentee's right to exclude." *Markman*, 52 F.3d at 978 (citing *Merrill v. Yeomans*, 94 U.S. 568, 573-74 (1877), and *Hogg v. Emerson*, 47 U.S. (6 How.) 437, 484 (1848)).

Armed with knowledge of the metes and bounds of a patent, a competitor may proceed to design around a patent. "Designing around" is not a wrong prohibited by the Patent Code, but benefits the patent system by furthering the constitutional purpose of promoting progress in the useful arts. *See Slimfold Mfg. Co. v. Kinkead Industries, Inc.*, 932 F.2d 1453, 1457 (Fed. Cir. 1991), and *Hilton Davis Chem. Co. v. Warner-Jenkinson Co.*, 62 F.3d 1512, 1520 (Fed. Cir. 1995) (in banc), *cert. granted*, ___ U.S. ___, 116 S.Ct. 1014 (1996). It is not only fair, but required, that the meaning of a patent claim be ascertained where possible from the patent. Otherwise, it would be virtually impossible to ascertain the scope of a patent to any reasonable degree. Scope would depend on the creativity of lawyers and experts at trial and not on the meaning conveyed by the inventor in the patent. The construction of the claims of a patent is exclusively within the province of a court as a question of law. *Markman*, 517 U.S. at ___, 116 S.Ct. at 1387.

Thus, irrespective of what practice the Federal Circuit may or may not follow in other cases where the meaning of a patent claim is ambiguous from reading the patent and its prosecution history, in this case, the Federal Circuit followed *Markman* and reached the only decision which is consistent with the language of the patent itself.

The Federal Circuit did not ignore the district court's decision. It carefully considered the district court's analysis and claims construction and found them flawed as a matter of law. The construction given the claims by the district court was inconsistent with the patent, and no quantum of extrinsic evidence can vary the meaning of a patent claim which is clearly evident from the patent. This process of independent review is not a waste of judicial resources: it demonstrates the efficient functioning of the appellate system to reach the correct result in cases where issues of law are the subject of the appeal. *See Salve Regina College v. Russell*, 499 U.S. 225, 231-32 (1991). This approach has been consistently followed by the Federal Circuit since its decision in *Markman* was affirmed by this Court. *E.g., Engel Indus. v. Lockformer Co.*, 96 F.3d 1398, 1403-04 (Fed. Cir. 1996); *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582 (Fed. Cir. 1996); *Amhil Enters. v. Wawa, Inc.*, 81 F.3d 1554, 1558, 1562 (Fed. Cir. 1996).

II. The Federal Circuit's Decision Here Is Fully In Accord With *Markman* and Other Decisions Of This Court.

The Federal Circuit in this case, in according independent review to a district court's construction of a claim, acted in accordance with – not contrary to – *Markman* and other Supreme Court decisions. This Court's decision in *Markman* very plainly and directly held that the interpretation of disputed claims of a patent is entrusted exclusively to a court as a matter of law. As such, and as remarked by the Federal Circuit, it is subject

to a *de novo* standard of review. Nor are the cases cited by the Petitioner to the contrary.

In *Salve Regina College v. Russell*, 499 U.S. 225, 233 (1991), for example, this Court said that "deferential review of mixed questions of law and fact is warranted when it appears that the district court is 'better positioned' than an appellate court to decide the issue in question or that probing appellate scrutiny will not contribute to the clarity of legal doctrine." In *Markman*, this Court made it very clear that uniformity of decision was not served by submitting an issue of claim construction of a patent to a jury. *Markman*, 517 U.S. at ___, 116 S. Ct. at 1396.[2] Uniformity, however, clearly is served by independent review by the Federal Circuit, which is expert in patent matters, as this Court expressly recognized in *Markman*: "It was just for the sake of such desirable uniformity that Congress created the Court of Appeals for the Federal Circuit as an exclusive appellate court for

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[2] The Petition notes that Justice Stevens in his dissent in *Gasperini v. Center for Humanities*, 518 U.S. ___, ___, 116 S.Ct. 2211, 2227 (1996), characterized claim construction as a mixed question of law and fact. However, Petitioner fails to mention that in doing so, Justice Stevens also recognized that this Court already had decided in *Markman* that claim construction would be treated as a question of law subject to independent review by the appellate court. *Id.* Thus, whether or not the issue of claim construction is purely a legal question or a hybrid of law and fact, this Court already has instructed lower courts on how to handle the issue. By taking the issue completely away from a jury and entrusting it exclusively to the court, the issue is treated by trial courts and by appellate courts alike as a question of law with well known implications on appeal.

patent cases . . . " *Markman*, 517 U.S. at ___, 116 S.Ct. at 1396 (citing H.R. Rep. No. 97-312, pp. 20-23 (1981)).

Thus, the Federal Circuit is uniquely in a better position than a trial judge to decide patent matters, and is not disadvantaged in claim construction by an inability to measure demeanor and credibility. The Federal Circuit rejected the trial court's claim construction, which rested on extrinsic evidence, because that construction did not comport with the patent instrument as a whole. The Federal Circuit easily was in the position to make this call without having to draw or ignore inferences or marshal "facts." The patent in this case was the controlling instrument. Thus, like Petitioner's unsuccessful assertion of demeanor and credibility to support its argument that claim construction was a jury issue in *Markman* (116 S.Ct. at 1395), Petitioner's assertions of demeanor and credibility here to support deference to a trial judge's legal conclusion stand on even softer ground.

Moreover, contrary to Petitioner's assertion, this Court in *Winans v. Denmead*, 56 U.S. (15 How.) 330, 338-39 (1854), long ago recognized that claim construction is a question of law to be determined by a court. (See discussion of *Winans* in *Markman*, 517 U.S. at ___, 116 S.Ct. at 1392). *Winans* recognized that all patent construction inquiries such as (i) what is the structure or device, described by the patentee, as embodying his invention; (ii) what mode of operation is introduced and employed by this structure or device; (iii) what result is attained by means of this mode of operation; and (iv) does the specification or claim cover the described mode of operation by which the result is attained – are legal inquiries for a court.

In sum, the Petitioner asserts that "the trial judge, as the principal receiver and evaluator of the evidence, is better positioned to assess the meaning of terms used in patent claims than is the court of appeals." (Petition at p. 1.) Petitioner never tells us why, except to suggest the already rejected arguments of demeanor and credibility. As this Court recognized in *Markman*, the Federal Circuit is a specialized court in patent matters with the mandate of creating uniformity in decision. The Federal Circuit is the appropriate place to decide questions of law pursuant to traditional standards of *de novo* review. This is the very decision reached by this Court in *Markman*, in affirming the decision of the Federal Circuit in that case.

CONCLUSION

The Federal Circuit in this case found that the district court's construction of the claims of the patent was legally wrong – it erased an important limitation in the patent claims and it was inconsistent with the patent. Understandably unhappy with that result, Petitioner attempts to create a Supreme Court issue. The Petition, however, presents an issue which this Court already has decided in *Markman v. Westview Instruments*, 517 U.S. ___, 116 S.Ct. 1384 (1996). The proper construction of disputed limitations in a claim is treated as a question of law, and as such it is subject to *de novo* review. Accordingly, this

Court should deny the Petition for a Writ of Certiorari to review the judgment of the Court of Appeals for the Federal Circuit in this case.

February 25, 1997

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